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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,953	11/30/2000	Guy McIlroy	PALM-3281.US.P	5875
7590 08/25/2004 WAGNER, MURABITO & HAO LLP Third Floor Two North Market Street San Jose, CA 95113			EXAMINER JACK, TODD M	
			ART UNIT 2133	PAPER NUMBER 4
DATE MAILED: 08/25/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/727,953

Applicant(s)

MCILROY, GUY

Examiner

Todd M Jack

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/07/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 22-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed Action.

DETAILED ACTION

Election/Restrictions

Group 1-

Claims 1-21: The claims of 1-21 deal with a method for security of software in a computer system classify in 713/187.

Group 2-

Claims 22-28: The claims of 22-28 deal with a portable computing device classify in 708/100.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention portable computing device has separate utility such as a transportable computing device. See MPEP § 806.05(d).

Because theses inventions are distinct for reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Anthony Murabido, attorney, on 09/727,953 a provisional election was made on traverse to prosecute the invention of a security of software in a computer system, claims 1-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 22-18 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 22-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected independent claim 22, generic or linking claim. Election was made **without** traverse in the reply filed on 08/19/2004.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benson (6,334,118 B1) in view of Ellison et al. (6,760,441 B1).

Claim 1: Benson teaches a computer system security for rental software (col. 5, lines 36-42), one service not permitted access by the customer unless the at least one usage parameter is within a predetermined threshold (col. 5, lines 19-24), the system security requires a smart card executing digital signatures (col. 8, lines 11-15), and using asymmetric cryptography the customer response means proves to the rented program that the customer response means has access to the customer's private keying material where the rented program does not permit the at least one service to the customer unless the proof is successful (col. 4, lines 9-18). Benson fails to teach loading the software on the computer system. Ellison teaches the loading software code that is currently active is used to load subsequent software code (col. 9, lines 9-12).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system by Benson by including the loading of software. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by Ellison et al., in order to provide updated security software to the computer system.

Claim 2: Benson fails to teach a method operates on an open platform computer system. Ellison teaches a platform include but are not limited or restricted to a

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computer, desktop office equipment, wireless telephone handset, a television set-top box, and the like (col. 2, lines 3-7).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system by Benson by including an open computer system. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by Ellison et al., in order to allow for other operating systems to interconnect to the computing system.

Claim 3: Benson fails to teach a host computer and a portable computing device coupled to the host computer. Ellison teaches a platform may be a desktop or laptop computer (col. 2, lines 1-7) and a platform include but are not limited or restricted to a computer, desktop office equipment, wireless telephone handset, a television set-top box, and the like (col. 2, lines 3-7) which can include multiple processors (col. 5, lines 27-30).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system by Benson to include a coupling of computing devices. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by Ellison et al., in order to allow multiple computing devices with slightly different functions to communicate and transfer acquired information to the host computer.

Claim 4: Benson fails to teach the software is supplied by a third-party source. Ellison teaches the operating system nub loads application modules (col. 4, lines 1-7).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system by Benson to include a third-party source supplied software. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by Ellison et al., in order to allow contractors to supply software desired by the user.

Claim 5: Benson fails to teach the third-party software is for execution or other use on a palmtop computer. Ellison teaches the operating system nub loads application modules (col. 4, lines 1-7) and a platform include but are not limited or restricted to a computer, desktop office equipment, wireless telephone handset, a television set-top box, and the like (col. 2, lines 3-7).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system by Benson to include third-party software used on a palmtop computer. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by Ellison et al., in order to allow non-system produced software to be utilized on a palmtop as part of the said computer system.

Claim 6: Benson teaches multiple applications of software reside on the system where each application has its own key file and access key files (col. 6, lines 43-53). The key access files validate the programs by their ability to allow the software to access the system.

Claim 7: Benson teaches the software vendor accesses the smart card via a network interface (col. 14, lines 47-48). Benson fails to teach a palmtop-computing device coupled to the network. Ellison teaches a platform include but are not limited or restricted to a computer, desktop office equipment, wireless telephone handset, a television set-top box, and the like (col. 2, lines 3-7).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system by Benson by including an open computer system. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by Ellison et al., in order to allow for other operating systems to interconnect to the computing system.

Claim 8: Benson teaches a computer system security for rental software (col. 5, lines 36-42) and one service not permitted access by the customer unless the at least one usage parameter is within a predetermined threshold (col. 5, lines 19-24). Benson fails to teach a host computer and a portable computing device coupled to the host computer. Ellison teaches an apparatus may be a desktop or laptop computer (col. 2,

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lines 1-7), a platform include but are not limited or restricted to a computer, desktop office equipment, wireless telephone handset, a television set-top box, and the like (col. 2, lines 3-7) which can include multiple processors (col. 5, lines 27-30).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system by Benson to include a host computer and a portable computing device. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by Ellison et al., in order to allow multiple computing devices with slightly different functions to communicate and transfer acquired information to the host computer which has master control over the security system.

Claim 9: Benson teaches the software vendor accesses the smart card via a network interface (col. 14, lines 47-48).

Claim 10: Benson fails to teach the portable computing device is a palmtop computing device. Ellison teaches a platform include but are not limited or restricted to a computer, desktop office equipment, wireless telephone handset, a television set-top box, and the like (col. 2, lines 3-7).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system by Benson to include a palmtop-computing device. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as

suggested by Ellison et al., in order to allow portable computing devices to remotely join the computer system, securely.

Claim 11: Benson fails to teach the portable computing device is a personal data assistant. Ellison teaches a platform include but are not limited or restricted to a computer, desktop office equipment, wireless telephone handset, a television set-top box, and the like (col. 2, lines 3-7).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system by Benson to include a portable computing device. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by Ellison et al., in order to allow personal data assistant computing devices to remotely join the computer system, securely.

Claim 12: Benson fails to teach the portable computing device is coupled to the host computer by an infrared device. Ellison teaches a platform include but are not limited or restricted to a computer, desktop office equipment, wireless telephone handset, a television set-top box, and the like (col. 2, lines 3-7) which can include multiple processors (col. 5, lines 27-30).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system by Benson to include an infrared device. This modification would have been obvious because a person having

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ordinary skill in the art would have been motivated to do so, as suggested by Ellison et al., in order to allow personal data assistant computing devices to remotely join the computer system, remotely.

Claim 13: Benson fails to teach a portable computing device is coupled to the host computer by an RF enabled device. Ellison teaches a platform include but are not limited or restricted to a computer, desktop office equipment, wireless telephone handset, a television set-top box, and the like (col. 2, lines 3-7) which can include multiple processors (col. 5, lines 27-30).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system by Benson to include an RF enabled device. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by Ellison et al., in order to allow personal data assistant computing devices to remotely join the computer system, remotely.

Claim 14: Benson teaches multiple applications of software reside on the system where each application has its own key file and access key files (col. 6, lines 43-53). The key access files validate the programs by their ability to allow the software to access the system.

Claim 15: Benson teaches the use of digital signatures checks, which will result in the flagging of the software as TRUE or FALSE (col. 9, lines 15-64). The statement TRUE or FALSE acts as a valid/invalid flag.

Claim 16: Benson fails to teach the palmtop computing device is configured to load third-party software files with the digital "valid" flag attached and to refrain from loading third-party software files which have no flag attached or have the "invalid" flag attached. Ellison teaches the rental server synchronizes access to the smart card and audit trail where the rental server cannot execute in a manner that thwarts system security. (col. 9, lines 1-22)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system by Benson to control the loading of software by the use of a valid/invalid flag. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by Ellison et al., in order to allow only authorized software access to the computer system.

Claim 17: Benson fails to teach the portable computing device is a palmtop computing device. Ellison teaches a platform include but are not limited or restricted to a computer, desktop office equipment, wireless telephone handset, a television set-top box, and the like (col. 2, lines 3-7).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system by Benson to include a palmtop-computing device. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by Ellison et al., in order to allow portable computing devices to remotely join the computer system, securely.

Claim 18: Benson teaches a computer system security for rental software (col. 5, lines 36-42), the software vendor accesses the smart card via a network interface (col. 14, lines 47-48), and one service not permitted access by the customer unless the at least one usage parameter is within a predetermined threshold (col. 5, lines 19-24). Benson fails to teach a palmtop-computing device coupled to the network. Ellison teaches a platform include but are not limited or restricted to a computer, desktop office equipment, wireless telephone handset, a television set-top box, and the like (col. 2, lines 3-7).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system by Benson to include a palmtop-computing device. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by Ellison et al., in order to allow portable computing devices to remotely join the computer system, securely.

Claim 19: Benson teaches multiple applications of software reside on the system where each application has its own key file and access key files (col. 6, lines 43-53). The key access files validate the programs by their ability to allow the software to access the system.

Claim 20: Benson fails to teach the palmtop computing device is configured to load third-party software files with the digital "valid" flag attached and to refrain from loading third-party software files which have no flag attached or have the "invalid" flag attached. Ellison teaches the rental server synchronizes access to the smart card and audit trail where the rental server cannot execute in a manner that thwarts system security. (col. 9, lines 1-22)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system by Benson to control the loading of software by the use of a valid/invalid flag. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by Ellison et al., in order to allow only authorized software access to the computer system.

Claim 21: Benson teaches the use of digital signatures checks, which will result in the flagging of the software as TRUE or FALSE (col. 9, lines 15-64). The statement TRUE or FALSE acts as a valid/invalid flag.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd M Jack whose telephone number is 703-305-1027. The examiner can normally be reached on M- Fridays.

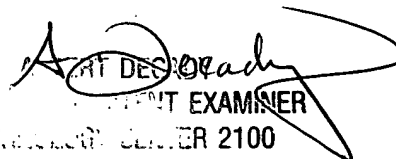
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 703-305-9595. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Todd Jack
Art Unit 2133

August 18, 2004



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